

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES**

<p>Appellants: Robert E. Haines et al.</p> <p>Title: HARDCOPY OUTPUT ENGINE CONFIGURATION APPARATUS AND METHOD</p> <p>Appl. No.: 09/976,626</p> <p>Filing 02/17/2004 Date:</p> <p>Examiner: Meucci, Michael D.</p> <p>Art Unit: 2142</p>	<p style="text-align: center;"><u>CERTIFICATE OF FACSIMILE TRANSMISSION</u></p> <p>I hereby certify that this paper is being facsimile transmitted to the United States Patent and Trademark Office, Alexandria, Virginia on the date below.</p> <div style="border: 1px solid black; height: 40px; margin-bottom: 5px;"></div> <p style="text-align: center;">(Printed Name)</p> <div style="border: 1px solid black; height: 40px; margin-bottom: 5px;"></div> <p style="text-align: center;">(Signature)</p> <div style="border: 1px solid black; height: 40px; margin-bottom: 5px;"></div> <p style="text-align: center;">(Date of Deposit)</p>
--	---

BRIEF ON APPEAL

Mail Stop Appeal Brief-Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

1. Real Party in Interest

The real party in interest is Hewlett-Packard Development Company, LP, a limited partnership established under the laws of the State of Texas and having a principal place of business at 20555 S.H. 249, Houston, TX 77070, U.S.A. (hereinafter "HPDC"). HPDC is a Texas limited partnership and is a wholly-owned affiliate of Hewlett-Packard Company, a Delaware corporation, headquartered in Palo Alto, California. The general or managing partner of HPDC is HPQ Holdings, LLC.

2. Related Appeals and Interferences

There are no related appeals or interferences that will directly affect, be directly affected by, or have a bearing on the present appeal, that are known to Appellants or Appellants' patent representative.

3. Status of Claims

Claims 1-26 were originally pending in the application. In response to a first substantive office action dated March 8, 2005 which rejected claims 1-26, claims 1, 8, 14 and 21 were amended and claims 27-35 were added. In response to an Office Action dated March 3, 2006, claims 9, 17 and 24 were canceled with their limitations incorporated into claims 8, 14 and 20, respectively, and claims 1, 8, 10-14, 21 and 32 were amended. In response to the Office Action mailed on May 29, 2007, claims 1 and 2 were amended. This is an appeal from the Final Office Action mailed on November 15, 2007 finally rejecting Claims 1-8, 10-16, 18-23 and 25-35. The present appeal is directed to Claims 1-8, 10-16, 18-23 and 25-35, i.e., all of the presently pending claims that stand rejected in this application.

4. Status of Amendments

No amendments were filed after the Final Office Action.

5. Summary of Claimed Subject Matter

A. Claim 1

Claim 1 recites a method of configuring a hard copy output engine, the method comprising:

receiving an electronic message including hard copy output engine configuration data from an undesignated website through a firewall, wherein the electronic message transmitted through the firewall designates a hardcopy output engine to be configured (Page 10, lines 17-20); and

configuring the hard copy output engine using the hard copy output engine configuration data. (Page 2, lines 15-18; Page 10, lines 17-20)

B. Claim 2

Claim 2 depends from claim 1 and further recites that receiving the electronic message comprises receiving an email at the hard copy output engine and wherein configuring comprises configuring the hard copy output engine via an embedded web server contained in the hard copy output engine using the hard copy output engine configuration data. (Page 10, lines 17-20).

C. Claim 3

Claim 3 depends from claim 1 and further recites that receiving the electronic message comprises receiving an email. (Page 10, lines 17-20).

D. Claim 4

Claim 4 depends from claim 1 and further recites that receiving the electronic message comprises:

receiving an email through the firewall at a first user station (Page 10, lines 17-20); and

forwarding the email to the hard copy output engine. (Page 10, lines 17-22).

E. Claim 5

Claim 5 depends from claim 1 and further recites that receiving the electronic message comprises receiving an XML script and configuring includes setting a threshold for an element chosen from a group consisting of: pigmentation material, marking material, number of hours of operation and number of sheets of print media consumed. (Page 9, lines 28-Page 10, line 3; Page 10, lines 6-8; Page 10, lines 27-31; Page 14, lines 16-19).

F. Claim 8

Claim 8 recites an apparatus comprising:

a device (14) configured to provide a computer instruction signal embodied in a carrier wave carrying instructions that when executed by a processor cause the processor to:

receive an electronic message including hard copy output engine configuration data from an undesignated website through a firewall (Page 10, lines 17-20); and

configure the hard copy output engine using the configuration data, wherein the computer instruction signal embodied in the carrier wave carrying instructions that cause the processor to receive an electronic message includes a computer instruction signal embodied in the carrier wave carrying instructions that cause the processor to receive an email at the hard copy output engine, and wherein the computer instruction signal embodied in the carrier wave carrying instructions that cause the processor to configure comprises a computer instruction signal embodied in the carrier wave carrying instructions that cause the processor to configure the hard copy output engine via an embedded web server contained in the hard copy output engine using the configuration data (Page 10, lines 17-20).

G. Claim 14

Claim 14 recites a computer implemented control system for a hard copy output engine, the system comprising:

memory (24) configured to store a software module (page 6, lines 12-15); and

processing circuitry (20) configured to employ the software module (page 6, lines 12-15) to:

receive an electronic message including hard copy output engine configuration data from an undesignated website through a firewall (Page 10, lines 17-22); and

configure the hard copy output engine using the configuration data (Page 10, lines 17-22), wherein the processing circuitry configured to employ the software module to receive an electronic message comprises processing circuitry configured to:

receive an email through the firewall at a first user station (Page 10, lines 17-20); and

forward the email to the hard copy output engine. (Page 10, lines 17-22)

H. Claim 20

Claim 20 depends from claim 14 and further recites that the processing circuitry configured to employ the software module to configure the hard copy output engine comprises processing circuitry configured to employ the software module to configure the hard copy output engine via the embedded web server (Page 10, lines 17-20) to set a threshold for an element chosen from a group consisting of: pigmentation material, marking material, number of hours of operation and number of sheets of print media consumed (page 9, lines 28-page 10, line 3; Page 10, lines 27-31; Page 9, lines 28-33; Page 14, lines 16-19).

I. Claim 21

Claim 21 recites an article of manufacture comprising a computer usable medium having computer readable code embodied therein that is configured to cause a processor to:

receive an electronic message including hard copy output engine configuration data from a website through a firewall (Page 10, lines 17-20); and
configure the hard copy output engine using the configuration data,
wherein the computer readable code configured to cause the processor to receive an electronic message includes computer readable code configured to cause the processor to:

receive an email through the firewall at a first user station (Page 10, lines 17-20); and

forward the email to the hard copy output engine. (Page 10, lines 17-22).

J. Claim 22

Claim 22 depends from claim 21 and further recites that the computer readable code configured to cause the processor to receive an electronic message includes computer readable code configured to cause the processor to receive an email at the hard copy output engine, and wherein the computer readable code configured to cause the processor to configure the hard copy output engine includes computer readable code configured to cause the processor to configure the hard copy output engine via an embedded web server contained in the hard copy output engine using the configuration data. (Page 10, lines 17-20)

K. Claim 26

Claim 26 depends from claim 21 and further recites that the computer readable code configured to cause the processor to receive an electronic message includes computer readable code configured to cause the processor to receive an XML script (Page 10, lines 6-8), and wherein the computer readable code configured to cause the processor to configure the hard copy output engine includes computer readable code configured to cause the processor to configure a hard copy output engine chosen from a group consisting of: facsimile machines, photocopiers and printers. (Page 3, lines 30-32).

L. Claim 27

Claim 27 recites a method comprising:

forming hard copy output engine configuration data on a first side of a firewall based upon input received from a second side of the firewall (Page 7, lines 24-28; Page 9, lines 28-page 10, line 3); and

transmitting an electronic message including the configuration data through the firewall to a hard copy output engine on the second side of the firewall. (Page 10, lines 4-6 and 17-20).

M. Claim 28

Claim 28 depends from claim 27 and further recites that the electronic message comprises an email. (Page 10, lines 17-20).

N. Claim 29

Claim 29 depends from claim 27 and further recites that transmitting the electronic message comprises:

transmitting the electronic message to a user station (Page 10, lines 17-20); and

forwarding the electronic message to the hard copy output engine. (Page 10, lines 17-22).

O. Claim 32

Claim 32 depends from claim 27 and further recites that the hard copy output engine configuration data designates a website on the first side of the firewall as a contact for the hard copy output engine, wherein the website was not previously designated to the hard copy output engine. (Page 9, lines 17-19; Page 10, lines and 8-11; Page 10, lines 14-16).

P. Claim 33

Claim 33 depends from claim 27 and further recites providing the input from the second side of the firewall to the first side of the firewall. (Page 7, lines 24-28; Page 9, lines 28-page 10, line 3).

Q. Claim 34

Claim 34 depends from claim 33 and further recites that the step of providing the input comprises interacting with a website on the first side of the firewall with a web browser on the second side of the firewall. (Page 7, lines 24-28; Page 9, lines 28-Page 10, line 3).

R. Claim 35

Claim 35 depends from claim 27 and further recites receiving the electronic message with a web server embedded in the hard copy output engine. (Page 10, lines 17-20).

6. Grounds of Rejection to be Reviewed on Appeal

The issue on appeal is whether the Examiner erred in rejecting Claims 1-8, 10-16, 18-23 and 25-35 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,333,790 (Kageyama) in view of US Patent Publication No. 2002/0065873 (Ishizuka).

7. Argument

I. Law of Obviousness

Claims 1-8, 10-16, 18-23 and 25-35 are rejected under 35 U.S.C. § 103(a), which states:

A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The legal standards under 35 U.S.C. § 103(a) are well-settled. Obviousness under 35 U.S.C. § 103(a) involves four factual inquiries: 1) the scope and content of the prior art; 2) the differences between the claims and the prior art; 3) the level of ordinary skill in the pertinent art; and 4) secondary considerations, if any, of nonobviousness. See Graham v. John Deere Co., 383 U.S. 1, 148 U.S.P.Q. 459 (1966).

In proceedings before the Patent and Trademark Office, the Examiner bears the burden of establishing a prima facie case of obviousness based upon the prior art. In re Piasecki, 745 F.2d 1468, 1471-72, 223 U.S.P.Q. 785, 787-88 (Fed. Cir.

1984). “[The Examiner] can satisfy this burden only by showing some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art would lead that individual to combine the relevant teachings of the references.” In re Fritch, 972 F.2d 1260, 1265, 23 U.S.P.Q. 2d 1780, 1783 (Fed. Cir. 1992).

As noted by the Federal Circuit, the “factual inquiry whether to combine references must be thorough and searching.” McGinley v. Franklin Sports, Inc., 262 F.3d 1339, 60 U.S.P.Q. 2d 1001 (Fed. Cir. 2001). Further, it “must be based on objective evidence of record.” In re Lee, 277 F.3d 1338, 61 U.S.P.Q. 2d 1430 (Fed. Cir. 2002). The teaching or suggestion to make the claimed combination must be found in the prior art, and not in the applicant’s disclosure. In re Vaeck, 947 F.2d 488, 20 U.S.P.Q. 2d 1438 (Fed. Cir. 1991). The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. In re Mills, 916 F.2d 680, 16 U.S.P.Q. 2d 1430 (Fed. Cir. 1990). “It is improper, in determining whether a person of ordinary skill would have been led to this combination of references, simply to ‘[use] that which the inventor taught against its teacher.’” Lee (citing W.L. Gore v. Garlock, Inc., 721 F.2d 1540, 1553, 220 U.S.P.Q. 303, 312-13 (Fed. Cir. 1983)). Teaching away from the claimed invention is a strong indication of non-obviousness and an improper combination of references. U.S. v. Adams, 383 U.S. 39 (1966).

II. The Examiner's Rejection of Claims 1-8, 10-16, 18-23 and 25-35 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,333,790 (Kageyama) in view of US Patent Publication No. 2002/0065873 (Ishizuka) Should be Reversed Because It Would Not Be Obvious to Modify Kageyama based upon Ishizuka so As to Include Every Limitation of Each of the Claims.

A. Claim 1

Claim 1 recites a method of configuring a hard copy output engine. The method includes receiving an electronic message including hard copy output engine configuration data from an undesignated web site through a firewall and configuring the hard copy output engine using the configuration data. The data transmitted through the firewall designates a hard copy output engine to be configured.

Neither Kageyama nor Ishizuka, alone or in combination, disclose a method which includes receiving an electronic message including hard copy output engine configuration data from an undesignated website through a firewall and configuring the hard copy output engine using the configuration data. In contrast, Kageyama merely discloses a printing system in which an updated program and data for a print controller of a printer controlled by a first computer and stored on a second computer is transmitted to the printer over a network. Ishizuka merely discloses a system by which a wireless mobile device may transmit data or files to be printed over a computer network.

In rejecting claim 1, the Examiner mischaracterizes what is actually taught by Kageyama and Ishizuka. The Examiner states:

Kageyama teaches: receiving an electronic message including hard copy output engine configuration data from an undesignated website, wherein the electronic message designates a hard copy output engine to be configured; and configuring the hard copy output engine using the configuration data (line 13-41 of the column 3 and lines 33-57 of the column 15).

(Final Office Action dated November 15, 2007, p. 2).

However, this is incorrect. Kageyama does not disclose receiving an electronic message. Kageyama does not disclose receiving an electronic message including hard copy output engine configuration data. Kageyama does not disclose receiving an electronic message including hard copy output engine configuration data from an undesignated website. Nowhere in line 13-41 of column 3 or lines 33-57 of column 15 is an electronic message ever mentioned. Nowhere in the cited portion of Kageyama is an electronic message containing configuration data ever mentioned. Moreover, as Kageyama is limited to interconnected computers and printers on a network, nowhere does Kageyama disclose that the electronic message including the hard copy output engine configuration data is from an undesignated website.

Ishizuka does not satisfy these deficiencies of Kageyama. In fact, Ishizuka says nothing about configuring a hard copy output engine. Rather, Ishizuka solely pertains to method for transmitting data from a wireless device to a printer on a network for printing.

Moreover, even assuming, arguendo, that it would be obvious to modify Kageyama based upon Ishizuka, the resulting hypothetical combination would not result in the method recited in claim 1. Rather, the resulting hypothetical combination, at most, would result in the printer of Kageyama being configured using the method disclosed by Kageyama, wherein the printer receives data files to be printed from a wireless device using the method disclosed by Ishizuka. Nothing in Kageyama or Ishizuka provides any motivation for the selective picking and choosing of features so as to result in the method recited in claim 1. Any such assertion would appear to be based upon impermissible hindsight reasoning using Appellents' own disclosure as a blueprint for such selective modification of Kageyama based upon Ishizuka.

In apparent recognition that the above originally cited basis for the rejection of claim 1 was weak at best, the Examiner responded in the Final Office Action by additionally citing an entirely different portion of Kageyama, column 3, lines 20-28.

However, this newly cited portion of Kageyama also fails to satisfy the limitations of claim 1. Column 3, lines 20-40 of Kageyama specifically states:

In the operation of this system, the second computer transmits information for proposing updating of a program and data for the first computer to the printer controller. The printer controller then transmits the proposal information to the first computer. The first computer then transmits updating request information for requesting an update of the program and the data for the first computer to the printer controller; and the printer controller transmits the updating request information to the second computer. The second computer reads the requested program and the requested data, and then transmits the requested program and the requested data to the printer controller. The printer controller receives and stores the program and the data, and transmits the program and the data to the first computer. The first computer receives and stores the program and the data for the first computer and then notifies a user of completion of updating by displaying updating completion information on a screen using a user interface. The user of the first computer, having been notified of the completion of updating by the updating completion information, instructs the printer to print using the updated program and the updated data.

(Kageyama, column 3, lines 28-40). In short, this portion of Kageyama merely discloses a first computer and a second computer connected to a printer via a network. The first computer instructs the printer to print while a second computer contains an updated program and data for the printer controller. In operation, first, the second computer notifies the printer of a proposed program update. Second, the print controller transmits the received proposal to the first computer. Third, the first computer transmits a request for the update to the printer controller. Fourth, the printer controller transmits a request to second computer. Fifth, the second computer then transmits the requested update program to the printer controller.

The Examiner attempts to argue that this new portion of Kageyama now satisfies all of the claim limitations of claim 1 except for the recited firewall. This is not true.

First, Kageyama does not disclose receiving an electronic message. The mere fact that the second computer "transmits" the requested program and requested data to the printer controller says nothing about the transmission being part of an "electronic message."

Second, Kageyama does not disclose receiving an electronic message including hard copy output engine configuration data. Nowhere does Kageyama disclose that the updated program and data for the printer controller is transmitted as part of an electronic message.

Third, Kageyama does not disclose receiving an electronic message including hard copy output engine configuration data from an undesignated website. Nowhere does Kageyama ever characterize the second computer as a WEBSITE. One of ordinary skill in the art would never consider a computer, by itself to somehow constitute a WEBSITE. Moreover, since the second computer is specifically tied to the printer and the first computer via a dedicated network, the second computer clearly cannot be considered an "undesignated" website.

The Examiner further attempts to argue that many references could've been incorporated to teach the use of a firewall in a network. Although this may be true, adding a firewall to either the first computer or the second computer of Kageyama would not result in the method recited in claim 1 being carried out.

Once again, claim 1 recites receiving an electronic message including hard copy output engine configuration data from an undesignated website through a firewall. The only device in Kageyama that receives the updated program (presumably characterized as the "hard copy output engine configuration data" by the Examiner) is the printer controller. Neither the first computer nor the second computer ever receive hard copy output engine configuration data. Nowhere is there any suggestion that the printer controller be provided with a firewall. Therefore, even if a firewall would be added to the first computer and the second computer of Kageyama, the printer controller would still not be "receiving an electronic message

including hard copy output engine configuration data from an undesigned website THROUGH A FIREWALL." (Emphasis added).

Moreover, even if the printer of Kageyama were provided with such a firewall, the firewall would presumably block any update program or executable sent from an undesigned website. One of the objectives of Appellants' disclosure is that by attaching a program to an electronic message rather than transmitting the program directly, such hardware configuration data may be sent from an undesigned website. Neither Kageyama nor Ishizuka, alone or in combination, comes close to achieving this. Accordingly, the rejection of claim 1 should be reversed.

B. Claims 2 and 8

Claim 2 depends from claim 1 and recites that the electronic message comprises an e-mail and that the hard copy output engine includes an embedded Web server that configures a hard copy output engine using the configuration data. As defined in the Specification, the term "Web server" refers to a specialized program running on a server that supports TCP/IP protocol. (See page 7, lines 15-16).

Claim 8 recites an apparatus which includes a device configured to provide a computer instruction signal that when executed by a processor causes a processor to receive an electronic message, comprising an e-mail, including hard copy output engine configuration data from an undesigned website through a firewall and to further configure the hard copy output engine using the configuration data with an embedded Web server contained in the hard copy output engine.

Neither Kageyama nor Ishizuka, alone or in combination, disclose or suggest a method wherein an e-mail including hard copy output engine configuration data is received from an undesigned website through a firewall and wherein the hard copy output engine is configured by an embedded web server contained in the hard copy output engine using the hard copy output engine configuration data. In rejecting claim 2, the Examiner refers to column 3, line 13-41 of Kageyama. However, not once in lines 13-41 of column 3 of Kageyama is an "e-mail" ever mentioned.

Moreover, nowhere does the cited portion of Kageyama ever describe an e-mail that includes hard copy output engine configuration data or an embedded Web server.

Likewise, Ishizuka also does not disclose receiving an e-mail including hard copy output engine configuration data and configuring a hard copy output engine using an embedded Web server using the configuration data. Although Ishizuka discloses a print server 413, Ishizuka does not appear to disclose a Web server. The data received by print server 413 is not hardcopy output engine configuration data. Accordingly, the rejection of claims 2 and 8 should be reversed for this additional reason.

In the Final Office Action, the Examiner attempts to argue that:

It is clear that the configuration data is transmitted from a server to the hardcopy output engine as an electronic message. "In the operation of this system, the second computer transmits information or opposing updating of a program and data of the printer to the printer controller," (lines 20-22 of column 3 in Kageyama) clearly provide for updating the printer configuration.

(Final Office Action dated November 15, 2007, page 7).

However, this attempted response does not even address the actual claim limitations. First,, the Examiner has failed to establish that Kageyama or Ishizuka discloses receiving an E-MAIL including hardcopy output engine configuration data. Second, the Examiner has failed to establish that Kageyama or Ishizuka discloses that the printer of Kageyama includes a WEB SERVER that configures the printer using the hardcopy output engine configuration data. Accordingly, the Examiner has failed to establish a prima facie case of obviousness. The rejection of claims 2 and 8 should be reversed.

C. Claim 3

Claim 3 depends from claim 1 and recites that receiving the electronic message comprises receiving an e-mail.

As noted above with respect to the rejection of claim 2, neither Kageyama nor Ishizuka discloses receiving an e-mail which includes hard copy output engine configuration data. Accordingly, the rejection of claim 3 should be reversed for this additional reason.

D. Claims 4, 11, 14 and 21

Claim 4 depends from claim 1 and recites that receiving the electronic message comprises receiving an e-mail at a first user station and forwarding e-mail to the hard copy output engine.

Claim 11 depends from claim 8 further recites that the instructions cause a processor to receive an e-mail to the firewall a first user station and to forward e-mail to the hard copy output engine.

Claim 14 recites a computer implemented control system for a hard copy output engine. The system includes processing circuitry configured to employee a software module of memory to let printable one) receive an electronic message including hard copy output engine configuration from an undesignated website through a firewall and to configure the hard copy output engine using the configuration data. The processing circuitry further configured to receive an e-mail through the firewall in a first user station and forward the e-mail to the hard copy output engine.

Claim 21 recites an article of manufacture comprising a computer usable medium having computer readable code embodied therein is configured to cause a processor to (1) to receive an electronic message including hard copy output engine configuration data from a website through a firewall and to configure the hard copy output engine using the configuration data. The code is further configured to cause a processor to receive an e-mail through the firewall at a first user station and forward the e-mail to the hard copy output engine.

As noted above, neither Kageyama nor Ishizuka disclose receiving an e-mail, let alone, forwarding an e-mail to a hard copy output engine. Thus, the rejection of

claims 4, 14 and 21 should be reversed for this additional reason. The rejection of claims 15-16 and 18-20, which depend from claim 14 should also be reversed. The rejection of claims 22-23 and 25-26, which depend from claim 21, should be reversed for at least the same reasons.

E. Claim 5

Claim 5 recites that receiving an electronic message comprises receiving an XML script and configuring includes setting a threshold for an element chosen from a group consisting of pigmentation material, marking material, number of hours of operation and number of sheets of print media consumed.

Neither Kageyama nor Ishizuka disclose receiving an electronic message comprising XML script including hard copy output engine configuration data. As acknowledged by the Examiner, Kageyama does not disclose receiving an XML script. As a result, the Examiner attempts to additionally rely upon Ishizuka. However, Ishizuka only discloses receiving an XML file including data that is to be printed. Nowhere does Ishizuka come close to suggesting that the XML file may include thresholds for the claimed elements.

The Examiner asserts that simply because Ishizuka discloses the receipt of XML files, "one of ordinary skill in the art at the time of the applicant's invention would have been motivated to receive the electronic message as an XML script in the system as taught by Kageyama."

However, as noted above, Kageyama fails to disclose receiving an electronic message. Moreover, simply because Ishizuka discloses a printer that receives XML files to be printed would not lead one of ordinary skill in the art to somehow modify Kageyama to receive XML script for configuring a printer. As noted above, at most, Ishizuka would merely lead one of ordinary skill in the art to enable the printer to receive XML files including thresholds for the claimed pigmentation material, marking material, number of hours of operation and number of sheets of print media consumed.

In response to such points, the Examiner attempts to argue that:

However, Ishizuka discloses: "in any event, PDF, HTML, and XML files enable wireless mobile device 106 to printed using printer 110 whether or not the wireless mobile devices utilizing the printer driver associated with the printer 110, "(paragraph [0044] on page 4). From this citation, it is clear that printer configuration data is sent in the message because the states at the mobile device will use a printer, even if the mobile device does not use the printer's current configuration data.

(Final Office Action dated November 15, 2007, page 8).

However, this is a mischaracterization of what is actually taught by Ishizuka. Nowhere does Ishizuka disclose that the printer configuration data is sent in the message. The reason that the wireless mobile device 106 of Ishizuka is able "to print using printer 110 whether or not the wireless mobile devices utilizing the printer driver associated with printer 110" is because print server 413 receives the file to be printed first and, after interpreting and formatting the information of the file, sends the interpreted and formatted information to the printer 110. (See the complete paragraph [0044]). In other words, it appears that the print server 413 reformats the data rather than reconfiguring the printer.

Note that nowhere does Ishizuka disclose that printer 110 is configured using configuration data; instead, the file to be printed is interpreted and formatted by print server 413. Note also that this attempted response still does not address the fact that neither Kageyama nor Ishizuka configure the printer by setting thresholds for the recited elements. Accordingly, the rejection of claim 5 should be reversed for this additional reason.

F. Claim 26

Claim 26 depends from claim 21 and recites that the computer readable code is configured to cause a processor to receive the electronic message comprising an XML script including the hardcopy output engine configuration data.

Neither Kageyama nor Ishizuka disclose receiving an electronic message comprising XML script including hard copy output engine configuration data. As acknowledged by the Examiner, Kageyama does not disclose receiving an XML script. As a result, the Examiner attempts to additionally rely upon Ishizuka. However, Ishizuka only discloses receiving an XML file including data that is to be printed. Nowhere does Ishizuka come close to suggesting that the XML file may include configuration data.

The Examiner asserts that simply because Ishizuka discloses the receipt of XML files, "one of ordinary skill in the art at the time of the applicant's invention would have been motivated to receive the electronic message as an XML script in the system as taught by Kageyama."

However, as noted above, Kageyama fails to disclose receiving an electronic message. Moreover, simply because Ishizuka discloses a printer that receives XML files to be printed would not lead one of ordinary skill in the art to somehow modify Kageyama to receive XML script for configuring a printer. As noted above, at most, Ishizuka would merely lead one of ordinary skill in the art to enable the printer to receive XML files to be printed.

In response to such points, the Examiner attempt to argue that:

However, Ishizuka discloses: "in any event, PDF, HTML, and XML files enable wireless mobile device 106 to printed using printer 110 whether or not the wireless mobile devices utilizing the printer driver associated with the printer 110, "(paragraph [0044] on page 4). From this citation, it is clear that printer configuration data is sent in the message because the states at the mobile device will use a printer, even if the mobile device does not use the printer's current configuration data.

(Final Office Action dated November 15, 2007, page 8).

However, this is a mischaracterization of what is actually taught by Ishizuka. Nowhere does Ishizuka disclose that the printer configuration data is sent in the message. The reason that the wireless mobile device 106 of Ishizuka is able "to print using printer 110 whether or not the wireless mobile devices utilizing the printer

driver associated with printer 110" is because print server 413 receives the file to be printed first and, after interpreting and formatting the information of the file, sends the interpreted and formatted information to the printer 110. (See the complete paragraph [0044]). In other words, it appears that the print server 413 reformats the data rather than reconfiguring the printer. Note that nowhere does Ishizuka disclose that printer 110 is configured using configuration data; instead, the file to be printed is interpreted and formatted by print server 413. Accordingly, the rejection of claim 26 should be reversed for this additional reason.

G. Claims 15 and 22

Claim 15 depends from claim 14 and recites that the processing circuitry employs a software module to configure the hard copy an output engine with an embedded Web server contained in the hard copy output engine.

Claim 22 depends from claim 21 and recites that the computer readable code is configured to cause a processor to configure the hardcopy output engine via an embedded Web server contained in the hard copy output engine using the configuration data.

Neither Kageyama nor Ishizuka, alone or in combination, disclose or suggest a method wherein the hard copy output engine is configured by an embedded Web server contained in the hard copy output engine using the hard copy output engine configuration data. In rejecting claims 15 and 22, the Examiner refers to column 3, line 13-41 of Kageyama. However, nowhere does the cited portion of Kageyama ever disclose that its printer includes an embedded Web server.

Likewise, Ishizuka also does not disclose configuring a hard copy output engine using an embedded Web server using configuration data received from an electronic message or an e-mail. Although Ishizuka discloses a print server 413, Ishizuka does not appear to disclose a Web server. The data received by print server 413 is not hardcopy output engine configuration data. Accordingly, the rejection of claims 15 and 22 should be reversed for this additional reason.

In the Final Office Action, the Examiner attempts to argue that:

It is clear that the configuration data is transmitted from a server to the hardcopy output engine as an electronic message. "In the operation of this system, the second computer transmits information or opposing updating of a program and data of the printer to the printer controller," (lines 20-22 of column 3 in Kageyama) clearly provide for updating the printer configuration.

(Final Office Action dated November 15, 2007, page 7).

However, this attempted response does not even address the actual claim limitation. The Examiner has failed to establish that Kageyama or Ishizuka discloses that the printer of Kageyama includes a **WEB SERVER** that configures the printer using the hardcopy output engine configuration data. Accordingly, the Examiner has failed to establish a prima facie case of obviousness. The rejection of claims 15 and 22 should be reversed.

H. Claim 20

Claim 20 depends from claim 14 and recites that the processing circuitry is configured to employ the software module to configure the hard copy output engine via the embedded Web server to set a threshold for an element chosen from a group consisting of: pigmentation material, marking material, number of hours of operation and number of sheets are print media consumed.

Neither Kageyama nor Ishizuka, alone or in combination, disclose or suggest a method wherein an embedded Web server contained in the hard copy output engine configures the hardcopy output mentioned by setting a threshold for an element chosen from a group consisting of: pigmentation material, marking material, number of hours of operation and number of sheets are print media consumed using the hard copy output engine configuration data. In rejecting claims 15 and 22, the Examiner refers to column 3, line 13-41 of Kageyama. However, nowhere does the cited portion of Kageyama ever disclose that it's printer includes an embedded Web server or that any alleged embedded Web server in figures the printer by setting a threshold for an element chosen from a group consisting of: pigmentation material,

marking material, number of hours of operation and number of sheets are print media consumed.

Likewise, Ishizuka also does not disclose configuring a hard copy output engine using an embedded Web server using configuration data received from an electronic message or an e-mail to set a threshold for any of the noted elements. Although Ishizuka discloses a print server 413, Ishizuka does not appear to disclose a Web server. The data received by print server 413 is not hardcopy output engine configuration data. Accordingly, the rejection of claim 20 should be reversed for this additional reason.

In the Final Office Action, the Examiner attempts to argue that:

It is clear that the configuration data is transmitted from a server to the hardcopy output engine as an electronic message. "In the operation of this system, the second computer transmits information or opposing updating of a program and data of the printer to the printer controller," (lines 20-22 of column 3 in Kageyama) clearly provide for updating the printer configuration.

(Final Office Action dated November 15, 2007, page 7).

However, this attempted response does not even address the actual claim limitations. First, the Examiner has failed to establish that Kageyama or Ishizuka discloses that the printer of Kageyama includes a **WEB SERVER** that configures the printer using the hardcopy output engine configuration data. Second, the Examiner has failed to establish that Kageyama or Ishizuka discloses using such a Web server to **SET A THRESHOLD** for one of the recited elements. Accordingly, the Examiner has failed to establish a prima facie case of obviousness. The rejection of claim 20 should be reversed.

F. Claims 27-35

The Examiner rejects claims 27-35 based upon Kageyama and Ishizuka by simply asserting that:

Claims 27-35 contain limitations similar to those disclose in claims 1-7 and are rejected under the same rationale.

(Final Office Action dated November 15, 2007, p. 5).

However, this is not true. Claims 27 and 35 contain distinct and different limitations. For example, claim 27 recites "forming hardcopy output engine configuration on a first side of a firewall based upon input received from a second side of the firewall." (Emphasis added). Claim 32 recites that the hardcopy output engine configuration data "designate a website on the first side of the firewall as a contact for the hardcopy output engine, wherein the website was not previously designated to the hardcopy output engine." Claim 34 recites that step for providing input comprises "interacting with a website on the first side of firewall with a web browser on the second side of the firewall." Neither Kageyama nor Ishizuka disclose such limitations. The Examiner has failed to assert where Kageyama and Ishizuka allegedly discloses such limitations. The Examiner has failed to establish a prima facie case of obviousness with respect to each of claims 27-35.

(1) Claim 27

Claim 27 recites a method which includes forming hardcopy output engine configuration data on a first side of the firewall based upon input received from a second side of the firewall. Claim 27 were further recites that the foreign hardcopy output engine configuration data is then transmitted with an electronic message through the firewall to a hardcopy output engine on a second side of the firewall.

Neither Kageyama nor Ishizuka disclose or suggest a method wherein hardcopy output engine configuration data is FORMED on a first side of the firewall based on input received from a second thought side of the firewall and wherein he formed hardcopy output engine configuration data is transmitted through the wire wall to the hardcopy output engine on a second side of the firewall. As noted above, Kageyama merely discloses a first computer and a second computer connected to a printer via a network. The first computer instructs the printer to print while a second computer contains an updated program and data for the printer controller. In operation, first, the second computer notifies the printer of a proposed program

update. Second, the print controller transmits the received proposal to the first computer. Third, the first computer transmits a request for the update to the printer controller. Fourth, the printer controller transmits a request to second computer. Fifth, the second computer then transmits the requested update program to the printer controller.

Kageyama does not even discuss how the update program and data for the printer controller is ever formed. Kageyama simply states that the updated program and data already exist on the second computer. Given such, how can Kageyama possibly disclose this limitation?

Even assuming, arguendo, that would be obvious to add a firewall to the second computer as alleged by the Examiner, nowhere does Kageyama disclose that the printer controller ever provides input to the second computer and that the second computer then forms the updated program and information based upon the received input. The Examiner has failed to establish a prima facie case of obviousness with regard to claim 27. Accordingly, rejection of claim 27 should be reversed. The rejection of claims 28-35, which depend from claim 27 should be reversed for at least the same reasons.

(2). Claim 28

Claim 28 depends from claim 27 and recites at the electronic message which includes the hardcopy output engine configuration data recited in claim 27 comprises an email.

Once again, as noted above, nowhere does Kageyama or Ishizuka remotely suggest the transmission of hardcopy output engine configuration data as part of an e-mail. Accordingly, rejection of claim 28 should be reversed for release this additional reason.

(3) Claim 29

Claim 29 depends from claim 27 and recites that transmitting the electronic message comprises transmitting the electronic message to a user station and

forwarding electronic message to the hardcopy output engine. Once again, the electronic message is recited in claim 27 as including the hardcopy output engine configuration data.

Neither Kageyama nor Ishizuka, alone or in combination, disclose or suggest transmitting an electronic message including hardcopy output engine configuration data to a user station and then forwarding the same electronic message including the hardcopy output engine configuration data to the hardcopy output engine. In contrast, in Kageyama, the updated program and data are directly transmitted from the second computer to the printer controller. Accordingly, the rejection of claim 29 should be reversed for at least this additional reason.

(4) Claim 32

Claim 32 depends from claim 27 and recites that the hardcopy output engine configuration data designates a website on the first side of the firewall as a contact for the hardcopy output engine, wherein the website was not previously designated to the hardcopy output engine.

Neither Kageyama nor Ishizuka, alone or in combination, disclose or suggest hardcopy output engine configuration data that designate a website on the first side of the firewall as a contact for the hardcopy output engine, wherein the website was not previously designated to the hardcopy output engine. As noted above, the second computer of Kageyama is not a website. Accordingly, rejection of claim 32 should be reversed.

(5) Claim 33

Claim 33 depends from claim 27 and further recites the step of providing the input from the second side of the firewall to the first side of the firewall.

Neither Kageyama nor Ishizuka, alone or in combination, disclose or suggest providing the input from the second side of the firewall to the first side of the firewall. Nowhere does Ishizuka ever indicate that input is provided from the printer controller to the second computer, wherein the second computer uses input to form the

hardcopy output engine configuration data. Accordingly, rejection of claim 33 should be reversed.

(6) Claim 34

Claim 34 depends from claim 33 and further recites that the step of providing input comprises interacting with a website on the first side of the firewall with a web browser on the second side of the firewall.

Neither Kageyama nor Ishizuka, alone or in combination, disclose or suggest the method of claim 34 wherein the input comprises interacting with a website on the first side of the firewall with a web browser on the second side of the firewall. **First**, as noted above, the second computer of Kageyama is not a website. **Second**, as noted above, nor does Kageyama disclose that its printer includes a web browser. **Third**, nor does Kageyama disclose that its printer provides input to the second controller for forming the updated program and data contained in the second computer. Thus, the rejection of claim 34 should be reversed.

(7) Claim 35

Claim 35 depends from claim 27 and further recites receiving the electronic message with a web server embedded in the hardcopy output engine.

Neither Kageyama nor Ishizuka, alone or in combination, disclose or suggest receiving an electronic message including hardcopy output engine configuration data with a Web server embedded in the hardcopy output engine. As noted above, nowhere does Kageyama disclose that its printer includes a web server that receives an electronic message including hardcopy output engine configuration data. Accordingly, rejection of claim 35 should be reversed.

Conclusion

In view of the foregoing, the Appellants submit that Claims 1-8, 10-16, 18-23 and 25-35 are not properly rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,333,790 (Kageyama) in view of US Patent Publication No. 2002/0065873 (Ishizuka) and are therefore patentable. Accordingly, Appellants

respectfully request that the Board reverse all claim rejections and indicate that a Notice of Allowance respecting all pending claims should be issued.

Summary

For the foregoing, it is submitted that the Examiner's rejections are erroneous, and reversal of the rejections is respectfully requested.

Dated this 30th day of June, 2008.

Respectfully submitted,

P.O. Address:

RATHE PATENT & IP LAW
10611 W. Hawthorne Farms Lane
Mequon, WI 53097
Telephone: (262) 478-9353

By Todd A. Rathe

Todd A. Rathe
Registration No. 38,276

CLAIMS APPENDIX

1. (Previously Presented) A method of configuring a hard copy output engine comprising:

receiving an electronic message including hard copy output engine configuration data from an undesignated website through a firewall, wherein the electronic message transmitted through the firewall designates a hardcopy output engine to be configured; and

configuring the hard copy output engine using the hard copy output engine configuration data.

2. (Previously Presented) The method of claim 1, wherein receiving the electronic message comprises receiving an email at the hard copy output engine and wherein configuring comprises configuring the hard copy output engine via an embedded web server contained in the hard copy output engine using the hard copy output engine configuration data.

3. (Previously Presented) The method of claim 1, wherein receiving the electronic message comprises receiving an email.

4. (Previously Presented) The method of claim 1, wherein receiving the electronic message comprises:

receiving an email through the firewall at a first user station; and
forwarding the email to the hard copy output engine.

5. (Original) The method of claim 1, wherein receiving the electronic message comprises receiving an XML script and configuring includes setting a threshold for an element chosen from a group consisting of: pigmentation material, marking material, number of hours of operation and number of sheets of print media consumed.

6. (Original) The method of claim 1, wherein the hard copy output engine is chosen from a group consisting of: facsimile machines, photocopiers and printers.

7. (Original) The method of claim 1, wherein the configuration data include data prepared by:

- determining a make and model for the hard copy output engine;
- determining a serial number for the hard copy output engine; and
- determining user thresholds for consumables associated with the hard copy output engine.

8. (Previously Presented) An apparatus comprising:

- a device configured to provide a computer instruction signal embodied in a carrier wave carrying instructions that when executed by a processor cause the processor to:
 - receive an electronic message including hard copy output engine configuration data from an undesignated website through a firewall; and
 - configure the hard copy output engine using the configuration data,

wherein the computer instruction signal embodied in the carrier wave carrying instructions that cause the processor to receive an electronic message includes a computer instruction signal embodied in the carrier wave carrying instructions that cause the processor to receive an email at the hard copy output engine, and wherein the computer instruction signal embodied in the carrier wave carrying instructions that cause the processor to configure comprises a computer instruction signal embodied in the carrier wave carrying instructions that cause the processor to configure the hard copy output engine via an embedded web server contained in the hard copy output engine using the configuration data.

9. (Canceled)

10. (Previously Presented) The apparatus of claim 8, wherein the computer instruction signal embodied in the carrier wave carrying instructions that cause the processor to receive an electronic message includes a computer instruction signal embodied in the carrier wave carrying instructions that cause the processor to receive an email through the firewall.

11. (Previously Presented) The apparatus of claim 8, wherein the computer instruction signal embodied in the carrier wave carrying instructions that cause the processor to receive an electronic message includes a computer instruction signal embodied in the carrier wave carrying instructions that cause the processor to:

receive an email through the firewall at a first user station; and
forward the email to the hard copy output engine.

12. (Previously Presented) The apparatus of claim 8, wherein the computer instruction signal embodied in the carrier wave carrying instructions that cause the processor to cause the processor to configure the hard copy output engine includes a computer instruction signal embodied in the carrier wave carrying instructions that cause the processor to configure the hard copy output engine via the embedded web server to set a threshold for an element chosen from a group consisting of: pigmentation material, marking material, number of hours of operation and number of sheets of print media consumed.

13. (Previously Presented) The apparatus of claim 8, wherein the computer instruction signal embodied in the carrier wave carrying instructions that cause the processor to receive an electronic message includes a computer instruction signal embodied in the carrier wave carrying instructions that cause the processor to receive an XML script, and wherein the computer instruction signal embodied in the carrier wave carrying instructions that cause the processor to configure the hard copy output engine includes a computer instruction signal embodied in the carrier wave carrying instructions that cause the processor to configure a hard copy output engine chosen from a group consisting of: facsimile machines, photocopiers and printers.

14. (Previously Presented) A computer implemented control system for a hard copy output engine, the system comprising:

memory configured to store a software module; and
processing circuitry configured to employ the software module to:

receive an electronic message including hard copy output engine configuration data from an undesignated website through a firewall; and
configure the hard copy output engine using the configuration data, wherein the processing circuitry configured to employ the software module to receive an electronic message comprises processing circuitry configured to:
receive an email through the firewall at a first user station; and
forward the email to the hard copy output engine.

15. (Original) The computer implemented control system of claim 14, wherein the processing circuitry configured to employ the software module to receive an electronic message comprises processing circuitry configured to employ the software module to receive an email at the hard copy output engine, and wherein the processing circuitry configured to employ the software module to configure the hard copy output engine comprises processing circuitry configured to employ the software module to configure the hard copy output engine via an embedded web server contained in the hard copy output engine.

16. (Previously Presented) The computer implemented control system of claim 14, wherein the processing circuitry configured to employ the software module to receive an electronic message comprises processing circuitry configured to employ the software module to receive an email through the firewall.

17. (Canceled)

18. (Original) The computer implemented control system of claim 14, wherein the processing circuitry configured to receive an electronic message comprises processing circuitry configured to employ the software module to receive an XML script.

19. (Original) The computer implemented control system of claim 14, wherein the hard copy output engine is chosen from a group consisting of: facsimile machines, photocopiers and printers.

20. (Original) The computer implemented control system of claim 14, wherein the processing circuitry configured to employ the software module to configure the hard copy output engine comprises processing circuitry configured to employ the software module to configure the hard copy output engine via the embedded web server to set a threshold for an element chosen from a group consisting of: pigmentation material, marking material, number of hours of operation and number of sheets of print media consumed.

21. (Previously Presented) An article of manufacture comprising a computer usable medium having computer readable code embodied therein that is configured to cause a processor to:

receive an electronic message including hard copy output engine configuration data from a website through a firewall; and

configure the hard copy output engine using the configuration data, wherein the computer readable code configured to cause the processor to receive an electronic message includes computer readable code configured to cause the processor to:

receive an email through the firewall at a first user station; and
forward the email to the hard copy output engine.

22. (Original) The article of manufacture of claim 21, wherein the computer readable code configured to cause the processor to receive an electronic message includes computer readable code configured to cause the processor to receive an email at the hard copy output engine, and wherein the computer readable code configured to cause the processor to configure the hard copy output engine includes computer readable code configured to cause the processor to configure the hard copy output engine via an embedded web server contained in the hard copy output engine using the configuration data.

23. (Previously Presented) The article of manufacture of claim 21, wherein the computer readable code configured to cause the processor to receive an electronic message includes computer readable code configured to cause the processor to receive an email through the firewall.

24. (Canceled)

25. (Original) The article of manufacture of claim 21, wherein the computer readable code configured to cause the processor to configure the hard copy output engine includes computer readable code configured to cause the processor to configure the hard copy output engine via the embedded web server to set a threshold for an element chosen from a group consisting of: pigmentation material, number of hours of operation and number of sheets of print media consumed.

26. (Original) The article of manufacture of claim 21, wherein the computer readable code configured to cause the processor to receive an electronic message includes computer readable code configured to cause the processor to receive an XML script, and wherein the computer readable code configured to cause the processor to configure the hard copy output engine includes computer readable code configured to cause the processor to configure a hard copy output engine chosen from a group consisting of: facsimile machines, photocopiers and printers.

27. (Previously Presented) A method comprising:
forming hard copy output engine configuration data on a first side of a firewall based upon input received from a second side of the firewall; and
transmitting an electronic message including the configuration data through the firewall to a hard copy output engine on the second side of the firewall.

28. (Previously Presented) The method of claim 27, wherein the electronic message comprises an email.

29. (Previously Presented) The method of claim 27, wherein transmitting the electronic message comprises:

transmitting the electronic message to a user station; and
forwarding the electronic message to the hard copy output engine.

30. (Previously Presented) The method of claim 27 further comprising configuring the hard copy output engine using the configuration data.

31. (Previously Presented) The method of claim 27 further comprising transmitting an electronic message including an address of the hard copy output engine from the second side of the firewall to the first side of the firewall.

32. (Previously Presented) The method of claim 27, wherein the hard copy output engine configuration data designates a website on the first side of the firewall as a contact for the hard copy output engine, wherein the website was not previously designated to the hard copy output engine.

33. (Previously Presented) The method of claim 27 further comprising providing the input from the second side of the firewall to the first side of the firewall.

34. (Previously Presented) The method of claim 33, wherein the step of providing the input comprises interacting with a website on the first side of the firewall with a web browser on the second side of the firewall.

35. (Previously Presented) The method of claim 27 further comprising receiving the electronic message with a web server embedded in the hard copy output engine.

EVIDENCE APPENDIX

There is no evidence previously submitted under 37 C.F.R. §§ 1.130, 1.131 or 1.132 or other evidence entered by the Examiner and relied upon by Appellant in this appeal. Accordingly, the requirements of 37 C.F.R. §§ 41.37(c)(1)(ix) are satisfied.

RELATED PROCEEDINGS APPENDIX

There are no decisions rendered by a Court of the Board in a proceeding identified in the Related Appeals and Interferences section. Accordingly, the requirements of 37 C.F.R. §§ 41.37(c)(1)(x) are satisfied.